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OCT 17 2002

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Paper No. 7

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AUG 02 2002

JUL 29 2002

In re Application of
Nachenberg et al.
Application No. 10/046,496
Filed: October 29, 2001
Attorney Docket No. 20423-05957

Received

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition, filed on March 25, 2002, requesting that a February 28, 2002 Notice to File Missing Parts of Nonprovisional Application for the above-identified application ("2/28/02 Notice") be withdrawn; and on the petition, filed by facsimile on July 9, 2002, requesting that this application be accorded a filing date of October 29, 2001 rather than the presently accorded filing date of November 29, 2001.¹

The 2/28/02 Notice from the Office of Initial Patent Examination (OIPE) advised Applicants that a filing date of November 29, 2001 had been accorded this application, that the signature of one of the inventors, Carey Nachenberg ("Nachenberg"), was missing from the declaration filed with the application, and that Figures 4, 5 and 7 appeared to have been omitted from the application as filed. In response, the instant petition was filed.

The instant petition requests a filing date of October 29, 2001 for this application, including Figures 4, 5 and 7, on the basis that the application with those figures of drawings was deposited in the U.S. Postal Service (USPS) "Express Mail Post Office to Addressee" service ("Express Mail") on that day pursuant to the requirements of 37 CFR 1.10.²

The petition is accompanied by a copy of the Express Mail mailing label bearing the number "EL566298875US" and an October 29, 2001 "date in" stamp. The application transmittal includes the same Express Mail mailing label number, and itemizes the application papers being mailed on October 29, 2001, e.g., specification including claims, drawings . . . , rendering the

¹ Two separate petitions were filed: (1) 3/25/02 petition [Certificate of Mailing date 3/14/02] to rescind the 2/28/02 Notice; and (2) 7/9/02 petition [Certificate of Mailing date 3/11/02] to accord the application a filing date of 10/29/01 [original petition to date not matched with application file; duplicate submitted by facsimile on 7/9/02]. The two petitions are hereby consolidated.

² Under 37 CFR 1.10(c) (Aug. 2001), any person filing correspondence that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, may petition the Commissioner if there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation; see also MPEP section 513 (Aug. 2001).

CC = M. Noto (Case 5957) - all has now been filed!
C. Nachenberg
FENWICK & WEST
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application entitled to the requested filing date of October 29, 2001.³

With respect to drawings, the Office file for this application includes only 5 sheets of drawings containing Figures 1, 2A, 2B, 3, and 6, but not 4, 5 or 7. Based on the information contained in Applicants' postcard receipt, the Office concludes that 8 sheets of drawings containing, *inter alia*, Figures 4, 5 and 7 had been filed on October 29, 2001, and that the 3 sheets containing Figures 4, 5 and 7 were later misplaced.

The petition to accord a filing date of October 29, 2001 for this application, including Figures 4, 5 and 7, is thus granted.⁴

The requirement for omitted figures in the 2/28/02 Notice was sent in error and is hereby vacated.

The petition also contends that the allegedly missing page of declaration containing Nachenberg's signature was in fact part of a 3-page declaration filed with the application papers on October 29, 2001.

The Office file for this application does not contain the page of declaration signed by Nachenberg. While Applicants' postcard receipt does not specify the number of pages in the Combined Declaration and Power of Attorney, and consequently cannot be relied upon for supporting the assertion that a 3-page declaration, including page 2 that bears Nachenberg's signature, was filed on October 29, 2001, the page of declaration signed by Nachenberg and enclosed with the instant petition has completed the declaration as required in the 2/28/02 Notice.⁵

³ See MPEP section 513 (Aug. 2001) (When a correspondence mailed by USPS "Express Mail" service includes several papers directed to the same application, it may be submitted with a transmittal which itemizes the papers. Merely placing the "Express Mail" mailing label number in one prominent location on such a transmittal is sufficient.).

Also, the application as filed on 10/29/01 includes the requisite components specified in 37 CFR 1.53(b) for a filing date, namely, a specification as prescribed by 35 U.S.C. 112, containing an enabling description of the claimed invention, the best mode of embodiment contemplated by the inventor for carrying out his invention, and at least one claim; as well as any necessary drawings as required by 35 U.S.C. 113 (1st sentence).

⁴ See 37 CFR 1.6(a) (Aug. 2001) (Correspondence received in the USPTO is stamped with the date of receipt except . . . (2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the USPS.). While aiding Applicants in obtaining the requested filing date, the USPS "Express Mail" mailing label does not prove that the missing drawings and the page of declaration signed by inventor Nachenberg were mailed with the application. See *infra* discussion.

⁵ The missing page of declaration was timely filed, in that, it was filed within 2 months of the 2/28/02 Notice.

The \$130 petition fee has been credited to Deposit Account No. 19-2555,⁶ and the \$130 surcharge for late filing of a proper oath/declaration has been charged to the same deposit account,⁷ both as authorized in the fee transmittal to the instant petition.

Finally, the Office acknowledges receipt on March 25, 2002 of a request to Rescind Previous Nonpublication Request (Form PTO/SB/36 (11-00)).

The application is being returned to OIPE for further processing with a filing date of October 29, 2001, for issuance of a corrected Filing Receipt, and for indication in USPTO records that 8 sheets of drawings were present on filing.

Telephone inquiries concerning this decision should be directed to Petitions Attorney RC Tang at (703) 308-0763.

Christina Donnell

Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

⁶ Completing an oath/declaration by timely responding to a notice of missing parts does not incur a petition fee.

⁷ 37 CFR 1.16(e).